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| Re Applic of | James N. Humenik, et al. |
| Docket No. | FIS920010261US1 |
| Serial No. | 10/026,239 |
| Filing Date | 12/21/01 |
| Attorney | Ira D. Blecker |

Attached: Reply Brief Pursuant to 37 CFR Section 14.41

PLEASE DELIVER TO: Andy Huynh
EXAMINER: ART UNIT: 2818
CONFIRMATION NO.: 3319
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| IN THE UNITED STATES PATENT AND TRADEMARK OFFICE | |
|--|---|
| In re application of: James N. Humenik, et al | Date: July 18, 2005 |
| Serial Number: 10/026,239 | Examiner: Alexander Markoff |
| Filed: 12/21/01 | Group Art Unit: 1746 |
| Title: Process for Electrolytically Cleaning Paste from a Workpiece | IBM Corporation D/18G, B/321, Zip 482 2070 Route 52 Hopewell Junction, NY 12533-6531 |

REPLY BRIEF PURSUANT TO 37 CFR §41.41

Commissioner of Patents and Trademarks
Alexandria, VA 22313

Dear Sir:

In the Examiner's Answer mailed May 17, 2005, the Examiner raised certain arguments that Appellants will respond to in this Reply Brief.

The double patenting rejection:

I. In Appellants' Appeal Brief, Appellants presented arguments and authorities (case law and MPEP) as to why copendency of the application and patent are required for a double patenting

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rejection. Yet, in the Examiner's Answer, the Examiner stated:

These arguments are based on the Appellant's own statements.

No requirement for copendency for making the obviousness-type double patenting rejections is presented in MPEP, cited authorities, other authorities, 37 CFR, or 35 USC. In contrast, MPEP 804 in contrast to the Appellant's statements requires to make the double patenting rejection when the conflicting claims are presented in the application and a patent which are commonly owned and have different inventive entities. It means that the obviousness-type double patenting rejection based on the patent filed prior to the filing date of the application is proper and should be made.

Appellants submit that the Examiner's statements are erroneous. Appellants did recite authorities on pages 6 to 8 of Appellants' Appeal Brief as to why copendency is or should be required when making a double patenting rejection. For example, Appellants recited In re Braithwaite, 379 F.2d 594, 601; 154 USPQ 29, 34 (CCPA 1967) wherein it was stated at n. 4: "While analogous to the non-obviousness requirement of 35 U.S.C. 103, that section is not itself involved in double patenting rejections because the patent principally underlying the rejection is not prior art." [emphasis added]

MPEP §804 moreover indicates in Chart II-B that a double patenting rejection is made in conjunction with a rejection under 35 USC §102(e)/103. Note the "And" in the portion of the Chart II-B for commonly owned inventions with different inventive entities. It is thus implicit in this Chart II-B, which forms a part of the MPEP, that unless there is a rejection available under 35 USC §102(e)/103 the double patenting rejection cannot be made. Since the present application was filed (December 21, 2001) after the issuance date of the patent (August 28, 2001), the 35 USC §102(e)/103 rejection should not be made. The rejection, rather, should be under 35 USC

§102(a) / 103. ("This provision [i.e., 35 USC §102(e)] of 35 U.S.C. 102 is mostly utilized when the publication or issue date is too recent for the reference to be applied under 35 U.S.C. 102(a) or (b)." MPEP §706.02(f).) In order for the 35 USC §102(e)/103 rejection to be made, there should be a period of copendency between the patent and application. Since the 35 USC §102(e)/103 rejection is required at the same time as the double patenting rejection according to Chart II-B, Chart II-B should also require a period of copendency between the application and patent. Accordingly, since there is no period of copendency between the present application and the patent, the double patenting rejection cannot be made under the MPEP.

II. The Examiner also recites on page 7 of the Examiner's Answer:

It is also noted that timewise for the purposes of double patenting analysis and 35 USC 103 analysis US Patent 6,280,527 is qualified not only as 35 USC 102(a) document, but also as 35 USC 102(e) document because no showing of common ownership at the time of the invention was provided. This also makes the Appellants arguments not persuasive.

It is believed that the Examiner is attempting to introduce a new ground of rejection in the Examiner's Answer. The Examiner has rejected the claims in the Final Office Action (p. 4) based on a 35 USC §102(e)/103 rejection. In fact, the Examiner admits (erroneously) in the Final Office Action and on page 4 of the Examiner's Answer that the patent "constitutes prior art only under 35 U.S.C. 102(e)." To now state that the reference qualifies as 35 USC §102(a) prior art (and presumably would now be applied through a 35 USC §102(a)/103 rejection) apparently introduces a new ground of rejection without explicitly stating so which would seem to conflict with 37 CFR §41.39 (a) (2). (It is noted that in the comments to new Rule 41.39 published 10/026,239

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August 12, 2004, the Office intends to amend the "MPEP requiring that any new ground of rejection made by an examiner in an answer must be personally approved by a Technology Center Director or designee and that any new ground of rejection made in an answer be prominently identified as such.") It is thus respectfully submitted that any statements the Examiner has made regarding the rejection of the claims under 35 USC §102(a)/103 be disregarded unless and until the Examiner specifically introduces a new ground of rejection rejecting the claims under 35 USC §102(a)/103.

The §103 rejection:

I. The Examiner continues to erroneously assert that the claims are rejected based on the patents being prior art only under 35 USC §102(e). "Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e)." (Examiner's Answer, p.4).

Since the patents in fact are not prior art solely under 35 USC §102(e) because they issued prior to the filing date of the present application as explained above and in Appellants' Appeal Brief, the Examiner's rejection of claims 1 to 16 based on 35 USC §102(e)/103 alone is erroneous.

If in fact the cited patents are prior art only under 35 USC §102(e), Appellants would be

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willing to show common ownership between the asserted patents and the present application. However, Appellants believe it would be unethical to claim common ownership for the purpose of benefitting from 35 USC §103(c) when Appellants believe that 35 USC §102(e) is not solely applicable here.

II. The Examiner also appears to give short shrift to Appellants' unexpected results and the treatment of those unexpected results according to In re Soni, 54 F.3d 746; 34 USPQ2d 1684 (Fed Cir. 1995).

Spring certainly does teach that the electrocleaning of metals does produce beneficial results. Spring further teaches that electrocleaning is one of many forms of cleaning (see first paragraph of page 67). However, Spring does not teach that electrocleaning is superior to any other method of cleaning of metals.

Appellants clearly have demonstrated the clear superiority of electrocleaning versus non-electrocleaning and that electrocleaning produces unexpected results. Such unexpected results have not been rebutted by the Examiner.

Summary:

In view of all of the preceding remarks and those remarks presented in Appellants' Appeal Brief, it is submitted that claims 1 to 16 are in condition for allowance, that the Examiner's various rejections of claims 1 to 16 are erroneous and reversal of the Examiner's decisions is respectfully requested.

Respectfully submitted,
James N. Humenik, et al.

By: 

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